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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,734	03/15/2004	Akihiko Asakawa	250251US0CONT	2076
22850	7590	05/17/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			HU, HENRY S	
			ART UNIT	PAPER NUMBER

1713

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/799,734

Applicant(s)

ASAKAWA ET AL.

Examiner

Henry S. Hu

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Amendment of March 30, 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 1713

1. It is noted that USPTO has received **Amendment** filed on March 30, 2006. **Claims 1, 3 and 6 were amended, new Claims 8-16 were added, while no claim was cancelled.** To be more specific, parent **Claim 1** was amended only to further limit the resin having Tg of 0-40 °C has crosslinkable reactive groups; Claim 3 was amended only to replace “characterized in that” with “wherein”, while Claim 6 was amended only to clarify the use of non-vinylidene fluoro resin being the one with Tg of 0-40 °C. The Applicants have alleged that support for such a claim amendment and addition can be found on page 6 of Remarks, particularly on page 12 at lines 12-16 and page 5 at lines 8-10 of specification.

2. The Applicants have corrected the improper paragraph on page 14 at line 23 by using the proper language of “**pivalate**” on **page 17 at line 4**. The Examiner thereby withdraws both specification objection and claim objection in the previous Office Action dated February 3, 2006. **Claims 1-16 are now pending** with only one independent claim (Claim 1). An action follows.

## **DETAILED ACTION**

### ***Response to Argument***

3. Applicant's argument filed on March 30, 2006 has been fully considered but they are not persuasive. The focal arguments related to the patentability will be addressed as follows: Such an amendment on parent Claim 1 involves only one thing: **to further limit the resin having Tg**

Art Unit: 1713

of 0-40 °C has crosslinkable reactive groups. After performing a further examination, previous rejections are sustained but some are with modified ground of rejection as follows:

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

Art Unit: 1713

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. *The limitation of parent Claim 1 in present invention relates to a fluororesin powder coating composition characterized by comprising a non-vinylidene fluororesin having a Tg higher than 40 °C and a resin having a Tg of from 0 to 40 °C, wherein the resin having a Tg of from 0 to 40 °C has crosslinkable reactive groups.*

*See other limitations of dependent Claim 2-16.*

7. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Uemae et al. (US 5,898,043) for the reasons set forth in paragraphs 6-7 of office action dated 2-3-2006 as well as the discussion below.

8. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being anticipated by Adachi et al. (US 5,998,507 or its equivalent GB 2,325,235 A) in view of Uemae et al. (US 5,898,043) for the reasons set forth in paragraphs 8-9 and 6-7 of office action dated 2-3-2006 as well as the discussion below.

9. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being obvious over Labana et al. (US 3,758,634) in view of Uemae et al. (US 5,898,043) for the reasons set forth in paragraphs 11-13 of office action dated 2-3-2006 as well as the discussion below.

Art Unit: 1713

10. **Applicants:** Applicants have now claimed in amended parent **Claim 1** an unexpected way of obtaining as a fluoro-resin powder coating composition. It may comprise (A) **a non-vinylidene fluoro-resin** having a Tg higher than 40 °C and (B) **a resin** having a Tg of from 0 to 40 °C having crosslinkable reactive groups.

As discussed in the interview summary for two 102 rejections, the Applicants again allege that in the case that both references including Uemae and Adachi may have used resins with the claimed Tg range at 0-40 °C. However, those resins are not carrying crosslinkable groups at all (for 102 rejections, see page 7 bottom section – page 8 top section for the reference Uemae; see page 8 bottom section for the reference Adachi).

11. For 103 rejection, as discussed earlier Labana has used **a non-fluorinated copolymer of glycidyl methacrylate with a Tg range at 40-90 °C** as component (A), he is therefore silent about two things **now**: (A) using a **fluorinated** analogue polymer and (B) having crosslinkable groups on resin with Tg of 0-40 °C. The secondary reference of Uemae or Adachi may be able to teach the use of such a fluorinated analogue. However, each of Uemae and Adachi cannot fix the new deficiency of “the resin having a Tg of from 0 to 40 °C has crosslinkable reactive groups” in amended parent Claim 1.

12. **Examiner:** In a close examination on currently amended parent Claim 1, such an amendment for parent Claim 1 involves **only one thing**: the resin having a Tg of from 0 to 40 °C has crosslinkable reactive groups. However, modified ground of rejection can be applied.

In response to Applicants' key argument as "both Uemae and Adachi does not have crosslinkable reactive groups on the resin having Tg at 0-40 °C", attention is directed to the fact **Uemae reference indeed discloses some resins**, to be useful as "film smoothness improver" or as "charge control agent", **may carry some crosslinkable groups** such as carboxylic acid or chlorine atom. Particularly see column 9, line 67 for "**chlorinated**" polyester, and "**acid group excessive**" polyester; see column 10, line 11-17 for **ethylene-"methacrylic acid" copolymer and a "maleic acid"-phenol resin**.

13. The Examiner agrees that Adachi reference may not disclose crosslinkable reactive groups on his water-dispersible resin (which has a Tg less than 40 °C (see column 6, line 51-61). As exactly pointed out by the Applicants in the interview summary of 3-29-2006, only non-functional group-containing monomers, such as (A) the **alkyl esters** of acrylic acid or methacrylic acid, (B) styrene and (C) the like, are used by Adachi in this regard.

With respect to **newly submitted Claims 8-16**, they are all dependent to parent Claim 1. All new claims are related to type of functional groups, type of resins, Tg temperature and polymer ratio in the blend, which can be taught by above-mention references alone or in combination.

In summary, **Uamae still anticipates limitation of newly amended parent Claim 1**. Accordingly, earlier 102(b) rejection by Uamae is sustained; earlier 102(b) rejection by Adachi is

Art Unit: 1713

converted to 103(a) rejection with the teaching of Uamae, while earlier 103(a) rejection is modified to be only existed for Labana/Uemae.

*Conclusion*

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communication from the examiner should be directed to **Dr. Henry S. Hu** whose telephone number is (571) 272-1103. The examiner can be reached on Monday through Friday from 9:00 AM –5:00 PM.



Art Unit: 1713

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The fax number for the organization where this application or proceeding is assigned is **(571) 273-8300** for all regular communications.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



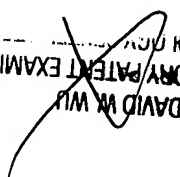
Henry S. Hu

Patent Examiner, Art Unit 1713, USPTO

May 14, 2006



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